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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,097	04/13/2004	Cynthia C. Bamdad	M1015.70013US01	3158

7590 06/29/2005

Timothy J. Oyer, Ph.D.
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Boston, MA 02210

EXAMINER

DO, PENSEE T

ART UNIT	PAPER NUMBER
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1641

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/823,097

Applicant(s)

BAMDAD ET AL.

Examiner

Pensee T. Do

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 276 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 276 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment Entry and Claim Status

The preliminary amendment filed on January 27, 2005 has been acknowledged and entered.

Claim 276 is pending. All other claims are cancelled.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 276 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 276 is indefinite because the preamble seems to be incomplete. The method for doing what? It is unclear as to what the purpose of the method is, a method of detecting, quantifying, or determining something?

Claim 276 is also indefinite for reciting "adapted to be fastened" because it is unclear of what is being modified so that the chemical or biological species is adapted to be fastened to the colloidal particle.

Claim 276 is also unclear of what the means for determining the immobilization of the first to second colloidal particle. Does the binding of the biological species give off some sort of signal when they become bound to each other therefore determining that the first colloidal particle is immobilized to the second colloidal particle?

Double Patenting

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 276 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/763,810 ('810). Although the conflicting claims are not identical, they are not patentably distinct from each other because Application '810 claims a method of exposing a first surface or region or a surface carrying a first immobilized component and a second surface or region of a surface carrying a second immobilized components to colloidal particles carrying immobilized species and determining immobilization of the colloidal particles to the first or second surface or region. The first and second surface or region can be of another colloidal particle. Thus, the method of application '810 has the same purpose of determining immobilization of the colloidal particles to the first or second surface or region of the other colloidal particles.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 276 is rejected under 35 U.S.C. 102(b) as being anticipated by Liberti et al. (US 5,108,933).

Liberti teaches manipulating colloids via magnetic separation. The method is using a first colloidal protein magnetite (first colloidal particle coated with first protein) and a second colloidal protein magnetite having a binding affinity for a determinant on the first colloidal protein magnetite. (see col. 18, line66-col. 19, line 2). Separation takes place before determining the immobilization of the first colloid particle with respect to the second colloidal particle. (see col. 18, lines 44-46).

Claim 276 is rejected under 35 U.S.C. 102(b) as being anticipated by Masson et al. (US 4,279,617).

Masson teaches a particle agglutination assay for antigens, antibodies and other binding proteins using two different, microscopic or submicroscopic particulate reagents. The first particulate reagent binds with the antigen or antibody under assay, and then the second particulate reagent which has a specific binding member attached thereto is added which binds only to those first reagent particles which have bound to the antigen or antibody under assay, so causing agglutination. The free unbound first and second particles are assayed to indicate the presence and/or amount of the antigen/antibody under assay. (see abstract, col. 1, line 64-col. 2, line 67; col. 4, lines 59-63).

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Determining the immobilization of the first and second particles is equivalent to the counting of the non-bound particles. The specification of the present invention describes that colloidal particles are nanoparticles including inorganic, organic, polymeric, ceramic, semiconductor, metallic (gold), non-metallic, etc. (see page 22, lines 4-11). The particles of Masson are latex which are less than 15 microns. (col. 2, lines 31-35).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pensee T. Do whose telephone number is 571-272-0819. The examiner can normally be reached on Monday-Friday, 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pensee T. Do
Patent Examiner
June 15, 2005


LONG V. LE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600
06/23/05